

REMARKS

Claims 1-105 are pending in this application. By this amendment, Applicant has amended claims 1, 20, 26, 39, 42, 53, 72, 78, 91, 94 and 105. Reconsideration of the above-identified application in view of the foregoing amendments and the following remarks is respectfully requested.

I. REQUEST FOR AN INTERVIEW

In a recent telephone call with the Examiner, the undersigned requested an interview to discuss this application. The request was denied on grounds that the outstanding Office Action was made “final” and allegedly addressed all of the arguments raised by Applicant in its Amendment dated March 10, 2004. During the telephone call, the Examiner indicated that if Applicant submitted a written response to the outstanding Office Action the Examiner would consider it and be willing to discuss the merits of the case with the undersigned over the telephone. Accordingly, Applicant respectfully submits this amendment and reiterates its request for an interview should the case not be allowed.

II. REJECTIONS UNDER 35 U.S.C. §112, ¶2

Claim 105 has been rejected under 35 U.S.C. §112, ¶2, for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 105 in this regard and respectfully requests that the foregoing rejection be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. § 103:

Claims 1-9, 12-34, 38-62, 65-86 and 90-104 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,815,086 to Ivie et al. (“Ivie”) in view of U.S.

Patent No. 6,020,881 to Naughton et al. ("Naughton"). Claims 10, 11, 35-37, 63, 64 and 87-89 are rejected under 35 U.S. C. 103(a) as being unpatentable over Ivie in view of Naughton as applied to claims 1-9, 12-34, 38-62, 65-86 and 90-104, and further in view of U.S. Patent No. 6,211,870 to Foster ("Foster"). Claims 1, 15, 17, 20, 23, 26, 38, 39, 42, 47, 49, 53, 67, 72, 75, 78, 90, 91, 94 and 99 are independent.

A. Claims 15, 17, 36, 37, 88 and 89

For the reasons set forth in Applicant's Amendment dated March 10, 2004, and elaborated upon herein, Applicant respectfully submits that claims 15, 17 36, 37, 88 and 89 are allowable over the prior art of record. Applicant further submits that the outstanding Office Action failed to address the arguments raised by Applicant in its March 10, 2004 Amendment with respect to these claims. To the extent these claims are not allowed in view of the following remarks, Applicant respectfully submits that, at the very least, the finality of the outstanding Office Action should be withdrawn and another Office Action issued in which Applicant's arguments vis-à-vis these claims are addressed. Moreover, Applicant submits that addressing them in an Advisory Action would be improper because doing so would unfairly prejudice Applicant given the passage of time. In other words, any reply to Applicant's arguments should have been included in the outstanding Office Action.

1. Claim 15

Applicant's invention, as defined by claim 15, is directed to a method for enabling a user of a wireless terminal to control a ubiquitous device, comprising: receiving information concerning an access point within whose operating range the wireless terminal is located; and transmitting for display on the wireless terminal a list of ubiquitous devices associated with the access point.

In the prior Office Action, the Examiner appears to have relied upon Ivie, col. 11/ lines 1-27, for claim 15's feature of "transmitting for display on the wireless terminal a list of ubiquitous devices associated with the access point". In particular, the Examiner stated "Ivie '086 also teaches: the wireless terminal display a list of electronic devices". Applicant traversed the rejection noting that, rather than the claimed feature, the cited passage instead is directed to a table *of the patent* that correlates each device (e.g., TV1, TV2, VCR, etc.) that a user may select by depressing one of the device selection switches 246 on hand-held transmitter 230 with a figure in the patent (e.g. 5A-5H) that illustrates the particular user interface that will appear on display 240 in response to the user's selection. As noted in the prior Amendment, however, nothing in Ivie teaches or suggests that the table of the patent, and thus a list, is transmitted to transmitter 230 and displayed thereon.

Now, in the outstanding Office Action, rather than addressing Applicant's arguments with respect to claim 15 vis-à-vis Ivie, the Examiner appears to have switched his position by relying on Naughton rather than Ivie for this claim feature and, in particular, by stating "Naughton is used to show ... a list of objects or spaces", citing FIGS. 2a-c of Naughton. This switch in position could not have been necessitated by Applicant's prior Amendment because Applicant did not therein amend claim 15 or any other claim containing the feature of "transmitting for display on the wireless terminal a list of ubiquitous devices associated with the access point".

In view of the foregoing, at the very least, the finality of the Office Action should be withdrawn. Moreover, as discussed in detail hereinafter, Naughton does not teach or suggest the above-cited claim feature, and thus, claim 15 should be allowed.

Applicant has reviewed the cited passages of Naughton and respectfully submits that these do not teach or suggest the feature of “transmitting for display on the wireless terminal a list of ubiquitous devices associated with the access point”. Rather than displaying a list, Naughton is directed to displaying objects, which are defined in Naughton as graphical icons, as shown in FIG. 7 of Naughton. In contrast, FIGS. 2A-2C of Naughton, upon which the Examiner relies for the claimed “list”, is merely directed to the structure of a map or, in other words, what is going on “under the hood” in Naughton to generate the display of FIG. 7. Thus, FIGS. 2A-2C of Naughton do not depict what is actually displayed to the user, and therefore, Naughton neither teaches nor suggests the feature of claim 15 of “transmitting for display on the wireless terminal a *list* of ubiquitous devices associated with the access point”. Indeed, the only motivation on the current record for this feature comes not from the cited references, but rather, impermissibly from Applicant’s disclosure.

For the foregoing reasons, Applicant respectfully submits that claim 15 is patentable over the combination of Ivie and Naughton. Claims 38, 67 and 90 contain limitations similar to claim 15 and are allowable for at least the same reasons as set forth above in urging the allowance of claim 15.

2. Claim 17

Claim 17 is directed to “a method for enabling a user of a wireless terminal located within the operating range of a first access point to control a ubiquitous device associated with a second access point, comprising: receiving a request for an identification of ubiquitous devices associated with the second access point; and transmitting an identification of a ubiquitous device associated with the second access point for display on the wireless terminal.”

In the prior Office Action, the Examiner rejected claim 17 over the combination of Ivie and Naughton without making any specific reference to the actual language of that claim. In responding to the rejection, Applicant noted that although a user in Ivie can control numerous appliances from the hand-held transmitter 230 regardless of where the appliances are located in the home, there is no teaching or suggestion in Ivie of “receiving a request for an identification of ubiquitous devices associated with the second access point; and transmitting an identification of a ubiquitous device associated with the second access point for display on the wireless terminal”, as required by claim 17.

Rather, in Ivie, all of the appliances of the automation system that can be controlled are known to the user by virtue of the device selection switches 246 of hand-held transmitter 230. The user can select one of those switches to display the functions assigned to each key on transmitter 230 in accordance with the device selected. In short, there does not appear to be any need in Ivie for a user to request an identification of ubiquitous devices associated with a second access point and, in response, receive an identification of such devices for display on the wireless terminal. Again, this is because all of the devices in the appliance automation system of Ivie are already known to the user by virtue of the device selection switches 246.

Moreover, Ivie does not provide any mechanism to allow a user to request, receive and display an identification of devices associated with a *specific* access point identified by the user that differs from the one with which the transmitter 230 is presently wirelessly communicating. (See also, e.g., claims 39 and 91) Instead, a user can only download and store the codes for all the devices in the appliance automation system and, in fact, may only be able to

more broadly download the codes for all manufactured devices, whether or not those devices are even part of the automation network of Ivie.

In the outstanding Office Action, the Examiner does not address Applicant's arguments with respect to claim 17. For this reason, at the very least, the finality of the Office Action should be withdrawn. However, since the claimed feature is neither taught nor suggested by the combination of Ivie and Naughton, Applicant respectfully submits that claim 17 is patentable over the cited references.

In addition, claims 23, 39, 47, 69, 75, 91 and 99 contain limitations similar to claim 17 and are allowable for at least the same reasons as set forth above in urging the allowance of claim 17.

3. Claims 36, 37, 88 and 89

In one embodiment of the present invention, a unique user identifier is used to determine the ubiquitous devices that the user is authorized to access. (See, e.g., p. 11, first full paragraph of the instant application.) Claims 36 and 88, which are directed to this access authorization feature, each requires that "the user identifier is an identifier associated with a SIM card." Claims 37 and 89 require that "the user identifier is a password."

In the prior Office Action, the Examiner rejected these claims in view of Foster. In responding to the Office Action, Applicant noted that neither of these two features -- an identifier associated with a SIM card or an identifier associated with a password -- is taught or suggested by Foster.

In the outstanding Office Action, the Examiner maintains this rejection but does not address the arguments raised by Applicant in its response with respect to these claims. For

this reason, at the very least, the finality of the Office Action should be withdrawn. However, since the claimed features are neither taught nor suggested by the combination of Ivie, Naughton and Foster, Applicant respectfully submits that claims 36, 37, 88 and 89 are patentable over the cited references.

B. Claim 1:

Applicant's invention, as defined by amended claim 1, is directed to a "method for enabling a user of a wireless terminal to control a ubiquitous device, comprising: receiving information concerning a location of the wireless terminal; determining data for display on the wireless terminal based upon a location of the wireless terminal, wherein the data includes a map representative of an area associated with an access point within whose operating range the wireless terminal is located and a user-selectable object representative of a ubiquitous device from the area for display on the map; and transmitting the data to the wireless terminal.

Applicant has amended claim 1 to more clearly define the unique location-based features of the present invention.

It is respectfully submitted that Ivie neither teaches nor suggests, among other things, the feature of "determining data for display on the wireless terminal based upon a location of the wireless terminal". The outstanding Office Action points out that appliance automation commands in Ivie are transmitted for display on wireless terminal 230. However, such commands are not "determined" for display on the wireless terminal "based upon the location of the wireless terminal". Rather, an entire library of commands is simply provided in response to an update request.

Applicant respectfully submits that Naughton also does not teach or suggest the feature of "determining data for display on the wireless terminal based upon a location of the

wireless terminal”. In particular, Naughton does not determine its world of spaces for display on device 170 based upon a location of device 170. Rather, in Naughton, the entire world of spaces organized into a geographic map structure is transmitted to device 170. The user may then navigate through the structure to display a space of interest to him.

Thus, Applicant respectfully submits that Ivie and Naughton, either alone or in combination, do not teach or suggest the claimed invention.

For the foregoing reasons, Applicant respectfully submits that claim 1 is patentable over Ivie in view of Naughton. Claims 20, 26, 42, 53, 72, 78 and 94, as amended, and claim 105, contain limitations similar to claim 1 and are allowable for at least the same reasons as set forth above in urging the allowance of claim 1.

C. Dependent Claims:

Dependent claims 10, 11, 35, 63, 64 and 87 were rejected as being unpatentable over Ivie in view of Naughton and further in view of Foster. Claim 10, which depends from claim 1, requires “receiving a user identifier; and determining the ubiquitous devices that the user is authorized to access based on the user identifier.” Claim 11, which depends from claim 10, requires “wherein the user-selectable object representative of the ubiquitous device is transmitted only if the user identifier indicates that the user is authorized to access the ubiquitous device.” Claims 63 and 64 contain limitations similar to claims 10 and 11. As mentioned above, the access authorization feature of the present invention is discussed on e.g., p. 11 of the instant application.

In the outstanding Office Action, the Examiner maintains that the “Foster invention is used to teach a programmable control unit 200 comprising a custom screen 1066 having softkeys 1161 and 1162 for indicating devices authorized to access by a specific user

identifier”. Applicant respectfully submits that Foster does not in any way restrict a user’s access to ubiquitous devices and thus does not determine the ubiquitous devices that the user is authorized to access. Rather, the softkeys referred to by the Examiner are merely a convenient mechanism for providing Dad’s favorite TV and radio stations. The first key is pre-programmed to turn on the television and cable box and then tune to Dad’s favorite cable channel – ESPN. The second key is pre-programmed to turn on the stereo receiver and tune it to Dad’s favorite radio station. Nothing in Foster, however, teaches or suggests that people other than Dad are prevented from having access to the television or radio. Rather, in Foster, anyone can access the devices by, e.g., depressing the same soft keys that Dad preprogrammed.

Thus, contrary to the Office Action, Foster neither teaches nor suggests at least “receiving a user identifier; and determining the ubiquitous devices that the user is authorized to access based on the user identifier”, as required by claim 10, and also clearly does not teach or suggest “wherein the user-selectable object representative of the ubiquitous device is transmitted only if the user identifier indicates that the user is authorized to access the ubiquitous device, as required by claim 11.

Accordingly, Applicant respectfully submits that claims 10 and 11 are not obvious in view of Ivie, Naughton and Foster. Claims 63 and 64 contain limitations similar to those found in claims 10 and 11 and are allowable for at least the same reasons.

Applicant does not believe it necessary at this time to further address the rejections of the dependent claims as Applicant believes that the foregoing arguments and amendments place the independent claims in condition for allowance. Applicant, however, reserves the right to address those rejections in the future should such a response be deemed necessary and appropriate.

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance, and an early and favorable examination on the merits is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required by this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4208-4001. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4001. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Respectfully submitted,
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By: _____


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